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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,046	04/15/2004	Richard J. Mackool	103471-51150	7400
26345	7590	11/02/2005		
GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE 1 RIVERFRONT PLAZA NEWARK, NJ 07102-5497			EXAMINER MCCORKLE, MELISSA A	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/825,046	<b>Applicant(s)</b> MACKOOL, RICHARD J.	
	<b>Examiner</b> Melissa A. McCorkle	<b>Art Unit</b> 3763	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 13 October 2005.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-5 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 7/25/05.

4) ☐ Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Sterile Tubing Sheath in the reply filed on 10/3/05 is acknowledged. The traversal is on the ground(s) that the classification of the method claims is improper and therefore does not warrant a restriction. This is not found persuasive because the sterilized barrier apparatus can be made by a materially different process (such as injection molding) than the process that is claimed (as stated in previous office action.) Therefore, the inventions are distinct (see MPEP § 806.05).

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "the surgical handpiece" in the middle of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1- 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailly et al (EP 0570255). Bailly et al discloses a sterilized barrier apparatus (6) comprising a sterile, tubular sheath (16), that is collapsible into a collapsed condition and expandable from the collapsed position into an expanded position (fig 3), a hollow extension tube (8) secured to a distal end of the sterile tubular sheath (fig 3), an aspiration tube (4) having a distal end with to which is attached the hollow extension tube (fig 3), the sterile, tubular sheath being secured to the aspiration tube (fig 3) at a location spaced from the distal end of the aspiration tube as being in the expanded condition (fig 3), further comprising a surgical pack that includes the surgical pack including a cassette arranged to receive contents of the aspiration tube that are being aspirated (col 1 lines 5-10), the aspiration tube having a proximal end closer to the cassette than the distal end of the aspiration tube (col 1 lines 5-10 and fig 3), the aspiration tube having a proximal end closer to the cassette than the distal end of the aspiration tube (col 1 lines 15-35), further comprising an instrument console with suction pump that, when activated, suctions the aspiration tube, the aspiration tube projecting from the instrument console (col 1 lines 5-10), further comprising a surgical handpiece (7 – a nozzle, col 2 lines 35-45) attached to the distal end of the aspiration tube (fig 3), and is capable of being attached to the distal end of the hollow extension tube (col 2 lines 35-45 and fig 3).

### ***Conclusion***


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morgan et al (US 6,740,074) discloses a Liquid Venting Surgical Cassette; Douglas et al (US 6,641,566) discloses a Reusable Medication Delivery

Device; Melanson et al (US 6,610,033) discloses a Dual Component Medicinal Polymer Delivery System and Methods of Use; Snedden (US 4,810,194) discloses a Disposable Antiseptic Dental Shield; Chandler (US 6,333,805) discloses a Syringe; Shekalim (US 2004/0176727) discloses an Insulin Pump.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa A. McCorkle whose telephone number is (571) 272-2773. The examiner can normally be reached on Monday - Friday, 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
NICHOLAS D. LUCCHESI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3763

Melissa A McCorkle  
Examiner  
Art Unit 3763

MAM  
10/23/05